

Mailed:

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

October 20, 2003
Paper No.14
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Trespa International B.V.**

Serial No. 75**663970**

Marilyn Matthes Brogan and William F. Lawrence of Frommer
Lawrence & Haug LLP for **Trespa International B.V.**

Catherine Pace Cain, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before **Simms, Hohein and Bottorff**, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Trespa International B.V. has filed an application to
register the mark "INSPIRATIONS" for "non-metal building panels,
non-metal boards for wall paneling and facades, [and] non-metal
partition walls, excluding windows."¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 75663970, filed on March 19, 1999, which is based on an
allegation of a bona fide intention to use the mark in commerce.

applicant's mark, when applied to its goods, so resembles the mark "INSPIRATIONS," which is registered for "windows,"² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.³ Here, inasmuch as the respective marks are identical in all respects, including the same overall commercial impression,⁴ it is plain that the contemporaneous use thereof in connection with the same or closely related goods would be likely to cause confusion as to their source or sponsorship. The principal focus of our inquiry is accordingly on the similarities and dissimilarities in the respective goods, including similarities and dissimilarities in

² Reg. No. 2,411,080, issued on December 5, 2000, which sets forth a date of first use anywhere and in commerce of June 25, 1998.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

⁴ Applicant, we observe, has not raised any argument to the contrary.

established, likely to continue channels of trade and the conditions under which and buyers to whom sales are made.

Applicant argues, among other things, that confusion is not likely from contemporaneous use of the marks at issue due to the differences in the respective goods, the differences in their channels of trade and classes of purchasers, the sophistication of the purchasers thereof and "the non-impulse conditions under which purchases are made." In particular, applicant notes that it "is in the business of providing strong, stylized paneling for both exterior and interior use" and that, as identified in its application, its goods specifically exclude windows. Thus, applicant contends that, not only do its goods "not overlap with those of Registrant," but the respective goods "have different purposes, attract different customers, and consequently do not compete for sales." Applicant also argues that "the differences in the trade channels [and classes of purchasers] ... mitigate against any likelihood of confusion," asserting that:

Applicant's products are offered to individuals, retailers, and manufacturers who require panels for buildings, boards for wall paneling and facades, and partition walls. The customers for Registrant's products are individuals and companies looking to purchase windows. Applicant's wall panels, facades and partitions are generally sold to professional [builders] and contractors. In contrast, Registrant's windows appear to be usually purchased [by] ... the individual consumer and homeowner. There is no evidence that the instant Applicant and the Registrant offer their products to the same customers or compete for sales.

In addition, applicant stresses that "when [purchasing] decisions are made either by sophisticated purchasers or after

careful examination of the product, there is a lesser likelihood of confusion." Applicant insists that in this case:

[T]he goods recited in this application and in the cited registration are not products that are generally bought on impulse ... but are purchased only after close consideration. The customers for such goods are generally knowledgeable about their field and have expertise in their trade.

Applicant, in consequence thereof, "respectfully contends that since the goods in question are purchased with care and deliberation by sophisticated purchasers, no confusion is likely."

As a final consideration, applicant urges that "[t]here is also an additional factor which further decreases the likelihood of confusion between the ... respective marks," namely, "the co-existence of a number of trademark applications and registrations containing the formative **INSPIR-** and the like, for a variety of goods and/or services." Referring, in this regard, to the lists of certain third-party applications and registrations for the mark "INSPIRATIONS," which it submitted as part of its response to various Office actions, applicant contends that registrant's mark "is weak, [and thus] the likelihood of confusion is reduced." Specifically, applicant states that it "conducted a trademark search on the United States Patent and Trademark Office website which uncovered approximately 33 marks for the work [sic] INSPIRATIONS alone and about 96 marks containing the word INSPIRATIONS as part of a composite mark."⁵

⁵ As to the latter, however, we note that applicant has not furnished any copies thereof or set forth other meaningful information, such as the associated goods or services for which the marks are registered or

The Examining Attorney, on the other hand, correctly points out that it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration, and not in light of what such goods are asserted to actually be. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where an applicant's and a registrant's goods are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods, and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Moreover, as the Examining Attorney properly notes, it is well established that an applicant's goods need not be identical or even competitive in nature with those of the

sought to be registered. In view thereof, and inasmuch as the Board does not take judicial notice of third-party registrations, see, e.g., In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974), the probative value of the approximately 96 composite "INSPIRATIONS" marks is essentially negligible.

registrant in order to support a finding of likelihood of confusion. It is sufficient, instead, that the respective goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In view of the above, the Examining Attorney maintains that:

Applicant's non-metal building panels, [non-metal] boards [for wall paneling and facades], and [non-metal] partition walls[, excluding windows,] and registrant's windows are highly related building products for home or office construction and improvement. The application and cited registration describe the goods broadly, with no limitations as to their ... channels of trade or classes of purchasers[.] Therefore, applicant's and registrant's building products are available to individuals or to professional contractors and travel in the same trade channels.

Moreover, while citing Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981), for the proposition that because the respective marks are identical, the relationship between the goods at issue "need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks," the Examining Attorney nonetheless contends

that the record shows that such goods are indeed so "highly related" as "building products for home or office construction and improvement" that, when marketed under the identical mark "INSPIRATIONS," confusion as to their source or sponsorship is likely to occur.

Specifically, the Examining Attorney notes that the record contains copies of various third-party registrations in which, in each instance, the same mark is registered for "a variety of building materials, including panels, walls and windows." It is settled, in this regard, that while use-based third-party registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, such registrations may nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988). Here, of the registrations referred to by the Examining Attorney which are based on use in commerce, several of those include, in each instance, such goods as the following: (i) "wood mouldings, wood panelings, ... [and] wood framed storm windows"; (ii) "millwork ...; wood mouldings; non-metal ceiling and door panels; ... and non-metal windows"; (iii) "windows ... and mill work"; (iv) "building materials; namely, ... windows ...; [and] exterior building panels and walls"; (v) "windows, ... and wall ... and other building panels"; (vi) "windows, ... [and] building

panels"; (vii) "laminated building panels, ... [and] storm windows"; and (viii) "non-metal ... building materials; namely, windows, ... [and] wall panels." In addition, to demonstrate the common channels of trade for applicant's and registrant's goods, the record includes five use-based third-party registrations for the following retailing and/or distributorship services: (i) "retail and wholesale store services ... featuring ... a variety of supplies for building, maintaining, repairing and improving buildings and homes, such as ... boards; supplies for ... paneling ...; moldings ...; windows"; (ii) "retail store services featuring building materials, ... windows,... [and] millwork"; (iii) "wholesale distributorships featuring windows, ... lumber and related millwork products used as building materials"; (iv) "retail store services involving millwork building materials, namely, windows, ... [and] decorative mouldings"; and (v) "wholesale distributorships featuring ... windows ..., moldings, [and] millwork."

The above evidence is sufficient to establish that applicant's non-metal building panels, non-metal boards for wall paneling and facades, and non-metal partition walls, excluding windows, are so closely related in a commercial sense to registrant's windows that the marketing of such products under the identical mark "INSPIRATIONS" would be likely to cause confusion as to origin or affiliation. Not only is it the case that the respective goods are of the types which may emanate from a single source, but contrary to applicant's arguments, such goods travel in the same channels of trade (e.g., retail building

materials stores and wholesale building supplies outlets) to the same classes of purchasers (including do-it-yourselfers and other ordinary consumers as well as professional builders and remodeling contractors). In particular, as the Examining Attorney persuasively points out in her brief:

When doing a construction or improvement project, it is entirely logical that a contractor, a homeowner, or an office project manager might purchase building panels, boards, partition walls, and windows for the same project. Therefore, the goods are complementary items.

Furthermore, as the Examining Attorney notes, applicant admits that there is significant overlap between the respective goods in terms of consumer purchasers and the same likewise would obviously be the case as to professional purchasers.

Significantly, in this regard, there not only is no limitation as to channels of trade or classes of purchasers with respect to the identification of applicant's goods, which as applicant concedes are "offered to individuals, retailers, and manufacturers who require panels for buildings, boards for wall paneling and facades, and partition walls," but there likewise is no restriction as to the methods of distribution and customer base with respect to the identification of registrant's "windows," which must be considered suitable for sale, as applicant acknowledges, to "individuals and companies looking to purchase windows."

Moreover, as to applicant's argument that there nevertheless is no likelihood of confusion inasmuch as the respective goods are purchased with care rather than impulsively

and the purchasers thereof "are generally knowledgeable about their field and have expertise in their trade," suffice it to say that while such generally would be true as to professional builders, remodeling contractors, construction project managers and the like, it is not necessarily the case with respect to such buyers as do-it-yourselfers and other ordinary consumers.

Nonetheless, even assuming that purchases of applicant's and registrant's closely related goods will be made with at least some degree of care and sophistication, it is well settled that the fact that consumers may indeed exercise deliberation in choosing the respective goods at issue "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). Such is especially the case where, as here, the marks at issue are identical in all respects.

Finally, with respect to applicant's contention that "the nature and number of similar marks containing the formative INSPIR- and/or the word INSPIRATIONS also mitigates against the likelihood of confusion," particularly since the mark "INSPIRATIONS" is weak in that it "is used and/or registered in connection with a variety of products or services," the Examining Attorney counters by accurately observing that "there is little value in focusing on the third-party [applications and] registrations because the ... goods and services [set forth

therein] are unrelated to those of the applicant and registrant in this case." In addition, inasmuch as the information provided by applicant with respect to third-party marks does not constitute proof of actual use of such marks so that it could otherwise be inferred that the purchasing public, having become conditioned to encountering various products and services under marks which consist of the word "INSPIRATIONS" or include the formative "INSPIR-", is accustomed to distinguishing the sources thereof, there simply is no demonstrated weakness as to registrant's mark. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). Thus, the asserted weakness of registrant's mark, as assertedly measured by the number and nature of the same and/or similar marks in use on similar goods and/or services is not a relevant *du Pont* factor in this appeal.

We accordingly conclude that consumers and potential customers, who are familiar or acquainted with registrant's "INSPIRATIONS" mark for "windows," would be likely to believe, upon encountering applicant's identical "INSPIRATIONS" mark for "non-metal building panels, non-metal boards for wall paneling and facades, [and] non-metal partition walls, excluding windows," that such closely related goods emanate from, or are sponsored by or associated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.